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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,503	11/05/2003	Veronique Chevalier	231895US0	6290
22850 7590 02/05/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER GHALI, ISIS A D	
			ART UNIT	PAPER NUMBER
			1615	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/05/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/700,503	CHEVALIER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Isis A. Ghali	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/15/2003</u> . | 6) <input type="checkbox"/> Other: ____  |

### **DETAILED ACTION**

The receipt is acknowledged of applicants' IDS filed 11/15/2003.

Claims 1-24 are pending and included in the prosecution.

#### ***Specification***

1. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
2. The use of the trademark "Rheolate" has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

#### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

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from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-45 of U.S. Patent No. 6,342,237 ('237) in view of US 6,238,654 ('654). The present claims and the claims of US '237 are directed to the common subject matter directed to composition for treating skin comprising fibers having specific dimensions and polyurethane in a physiologically acceptable medium. US '237 claims thickeners in claim 19, and on column 7 it described thickeners as associative polyurethanes having the same structure as instantly claimed. Polyurethane is further recited in claims 14 and 45 of the US '237. The present claims recite medium comprising aqueous phase and oil phase and the claims of US '237 recite oil and surfactants in claim 19.

The difference between the present claims and the claims of US '237 is that the present claims specify polyurethane as associative polyurethane and the physiologically

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acceptable medium comprises aqueous phase and oily phase. US '237 describes associative polyurethane, and claiming oil in the composition.

US '654 teaches composition suitable for cosmetics for hair and skin and has suitable viscoelastic properties allowing it to recover its initial appearance after each use (abstract; col.8, lines 21-23). The composition containing associative polyurethane in physiologically acceptable medium comprises aqueous phase and oil phase of oil-in-water type (col.1, lines 43-53; col.3, lines 20-22). The oily phase comprises from 0.1 to 30% of the total composition and comprises silicone oils (col.5, lines 21-22, 31-35). The reference disclosed that by virtue of associative polyurethane, the composition has thick texture, which spreads easily, rheofluidizable, and has significant viscoelasticity, and such objectives are achieved by combining aqueous phase, oily phase and associative polyurethane (col.1, line 67; col.2, lines 1-6). Associative polyurethane comprises 2.24% of the composition and includes those disclosed and used by applicants including SERAD FX 1100, Rheolate 278, Rheolate 244, DW 1206F and DW 1206J, (col.2, lines 22-35, 61-67; col.6, line 49; col.7, line 8). The composition further comprises any additional ingredients customarily used in the field of cosmetic and dermatology (col.5, lines 36-38).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide cosmetic topical composition for treating skin or hair comprising fibers and polyurethane in a physiologically acceptable medium as claimed by US '237, and replace the polyurethane by associative polyurethane in physiologically acceptable media comprising aqueous phase and oily phase as disclosed by US '654,

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motivated by the teaching of US '654 that by virtue of associative polyurethane, the composition has thick texture, spreads easily, rheofluidizable, and has significant viscoelasticity, and such objectives are achieved by combining aqueous phase, oily phase and associative polyurethane, with reasonable expectation of having composition comprising fibers and associative polyurethane in a physiologically acceptable medium comprising aqueous phase and oily phase that has thick texture, spreads easily, rheofluidizable, and has significant viscoelasticity.

***Claim Rejections - 35 USC § 112.***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 2 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 2, the expressions "acetate fibers", "polymer mixtures" and "surgical fibers" do not set forth the metes and bounds of the claims. Recourse to the specification does not define the expressions, or what are the possible acetate fibers, surgical fibers or polymer mixtures that are capable to form fibers suitable for the present invention.

Additionally, with regard to claim 2, a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the

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metes and bounds of the patent protection desired. The claims are rendered indefinite by raising a question or doubt introduced by the limitations following the expression "especially" because it is subject of more than one interpretation, and one interpretation would render the claim unpatentable over the prior art. In the present instance, the claim recites the broad limitation "carbon fibers" and narrower limitation "graphite form".

Claims 2 and 6 contain the trademark/trade names "Teflon" in claim 2 and "Nylon" in claim 6. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe fibers and, accordingly, the identification/description is indefinite.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being obvious over US '237 in view of US '654.

The applied reference US '237 has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the



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application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

US '237 teaches topical composition for treating skin comprising fibers and associative polyurethane in a physiologically acceptable medium (abstract; col.7, lines 33-34). The physiologically acceptable medium is aqueous medium present in amount of 1-70% of the composition, and may further comprise oils and surfactant, i.e. suggesting oily phase (col.6, lines 50-54; col.8, lines 48-54; claim 19). Fibers include polyamide Nylon fibers and poly-p-phenylene terephthalamide (col.2, lines 37-57). The fibers have length ranging from 10nm to 5mm and diameter ranging from 2nm to 500mm (col.2, lines 27-36; col.3, lines 6-11). The preferred amount of fibers in the composition is 0.5-50% (col.3, lines 26032). Associative polyurethane comprises 2.24% of the composition and includes those disclosed and used by applicants including SERAD FX 1100, Rheolate 278, Rheolate 244, DW 1206F and DW 1206J, (col.7, lines 35-50; col.8, lines 1-21). The amount of the associative polyurethane ranges from 0.1-20% by weight of the composition (col.8, lines 27-30).

US '237 suggests the presence of the oil in the composition and surfactant, i.e. emulsifier, however, US '237 does not explicitly teach physiologically acceptable medium comprises aqueous phase and oily phase as claimed in claim 1, the constituents and the amount of the oily phase as claimed by claims 15, 16, 18, and the emulsifier as claimed by claims 17 and 19.

US '654 teaches topical composition suitable for cosmetics for hair and skin and has suitable viscoelastic properties allowing it to recover its initial appearance after each use (Abstract; col.8, lines 21-23). The composition containing associative polyurethane in physiologically acceptable medium comprises aqueous phase and oil phase of oil-in-water type (col.1, lines 43-53; col.3, lines 20-22). The oily phase comprises from 0.1 to 30% of the total composition and comprises silicone oils (col.5, lines 21-22, 31-35). The reference disclosed that by virtue of associative polyurethane, the composition has thick texture, which spreads easily, rheofluidizable, and has significant viscoelasticity, and such objectives are achieved by combining aqueous phase, oily phase and associative polyurethane (col.1, line 67; col.2, lines 1-6). Associative polyurethane comprises 2.24% of the composition and includes those disclosed and used by applicants including SERAD FX 1100, Rheolate 278, Rheolate 244, DW 1206F and DW 1206J, (col.2, lines 22-35, 61-67; col.6, line 49; col.7, line 8). The composition further comprises any additional ingredients customarily used in the field of cosmetic and dermatology (col.5, lines 36-38).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide topical composition for treating skin comprising fibers and associative polyurethane in a physiologically acceptable medium including aqueous phase and oil as disclosed by US '237, and replace the physiologically acceptable medium by oil-in-water type medium comprising aqueous phase and oily phase as disclosed by US '654, motivated by the teaching of US '654 that the combination associative polyurethane in a medium comprising and aqueous phase and

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oily phase provides composition that has thick texture, which spreads easily, rheofluidizable, and has significant viscoelasticity, with reasonable expectation of having composition comprising fibers and associative polyurethane in a physiologically acceptable medium comprising aqueous phase and oily phase that has thick texture, spreads easily, rheofluidizable, and has significant viscoelasticity.

The combination of US '237 and US '654 does not teach the specific emulsifier as claimed by claim 19. The specific emulsifier does not impart patentability to the claims, absent evidence to the contrary.

10. Claims 1-6, 8-18, 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,001,338 ('338) in view of US '654, or vice versa.

US '338 teaches composition suitable for dermatological and cosmetic compositions comprising fibers to provide the composition in a thickened form that easily spreads without feeling sticky during application on after application (abstract; col.1, line 56-col.2, line 25). The fibers include wood fibers and cellulose fibers having length greater than 1  $\mu\text{m}$ , and length/diameter ratio greater than 10, i.e. thickness will be at least 0.1  $\mu\text{m}$  (col.2, lines 50-65; col.3, lines 3-10). The fibers form 0.1 to 30% by weight of the composition (col.3, lines 49-52). The composition comprises dermatologically acceptable medium, more comprises aqueous phase and fatty phase comprises oils or silicones to form oil-in-water emulsion (col.4, lines 35-40, 62-67; col.5, lines 1-12, 35-40). The composition is packaged (col.5, lines 48-50). The composition further comprises film-forming polymers (col.2, lines 1-2).

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US '338 teaches film forming polymer in the composition, however, does not does not explicitly teach polyurethane polymer.

The teaching of US '654 are discussed above.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide cosmetic or dermatological composition comprising fibers and polymer in a physiologically acceptable medium including aqueous phase and oil as disclosed by US '338, and replace the polymer by associative polyurethane disclosed by US '654, motivated by the teaching of US '654 that by virtue of associative polyurethane, the composition has thick texture, spreads easily, rheofluidizable, and has significant viscoelasticity, and such objectives are achieved by combining aqueous phase, oily phase and associative polyurethane, with reasonable expectation of having composition comprising fibers and associative polyurethane in a physiologically acceptable medium comprising aqueous phase and oily phase that has thick texture, spreads easily, rheofluidizable, and has significant viscoelasticity.

*Vise versa*, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide composition comprising associative polyurethane in physiologically acceptable medium comprising aqueous phase and oily phase and any additional ingredients customarily used in the field of cosmetic and dermatology as disclosed by US '654, and add the fibers disclosed by US '338 as an additional ingredient, motivated by the teaching of US '338 that fibers provide a cosmetic composition in a thickened form that easily spreads without feeling sticky during application on after application, with reasonable expectation of having cosmetic

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composition comprising fibers and associative polyurethane in a physiologically acceptable medium comprising aqueous phase and oily phase that has thick texture that easily spreads without feeling sticky during application on after application.

11. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of US '338 and US '654, and further in view of JP 07-196440 ('440).

The combined teachings of US '338 and US '654 are discussed above.

The combined teaching of US '338 and US '654 does not specifically teach Nylon fibers as claimed by claim 7.

JP '440 teaches composition comprising fibers to provide cosmetic formulation excellent in oil and water resistance and has make-up durability and capable for applying smooth touch to the skin and not sticky (abstract, paragraphs 0003-0005). The fibers are polyamide 6-Nylon fibers (claim 4; paragraph 0006). The composition is oil-in-water type composition (paragraph 0010).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide cosmetic composition comprising fibers and associative polyurethane in a physiologically acceptable medium comprising aqueous phase and oily phase as taught by the combined teaching of US '338 and US '654, and replace the fibers by polyamide Nylon-6 fibers disclosed by JP '440, motivated by the teaching of JP '440 that adding such fibers in cosmetic composition provided the composition with excellent resistance to oil and water, durability and capability for applying smooth touch to the skin and further the composition is not sticky, with

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reasonable expectation of having cosmetic composition comprising Nylon-6 fibers and associative polyurethane in a physiologically acceptable medium comprising aqueous phase and oily phase wherein the composition is not sticky and has excellent resistance to oil and water, durable and capable for applying smooth touch to the skin.

12. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over any of the combination of US '237 with US '654, or the combination of US '338 with US '654, each combination further in view of US 4,097,403 ('403)

The combined teachings of US '237 and US '654 and the combination of US '338 and US '654 are discussed above.

The combined teaching of US '237 and US '654 and the combined teaching of US '338 and US '654 do not teach the specific emulsifier as claimed by claim 19.

US '403 teaches improved emulsifier composition used in cosmetics which possesses excellent emulsifying and solubilizing properties to the oils and possesses reduced tendency towards coloration and bad odors (abstract; col.1, lines 57-61; col.2, lines 52-56). The emulsifier composition comprises polyoxyethylene sorbitol fatty ester (col.2, lines 65-68).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide cosmetic composition comprising fibers and associative polyurethane in a physiologically acceptable medium comprising aqueous phase and oily phase and surfactant as taught by the combined teaching of US '237 with US '654 and the combined teaching of US '338 with US '654, and replace the

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surfactant by polyoxyethylene sorbitol fatty ester disclosed by US '403, motivated by the teaching of US '403 that polyoxyethylene sorbitol fatty esters when used in cosmetics they provide excellent emulsifying and solubilizing properties to the oils in the composition and provide reduced tendency towards coloration and bad odors, with reasonable expectation of having cosmetic composition comprising fibers and associative polyurethane in a physiologically acceptable medium comprising aqueous phase and oily phase and polyoxyethylene sorbitol fatty esters as emulsifiers wherein the composition has excellent emulsifying and solubilizing properties to the oils and has reduced tendency towards coloration and bad odors.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 6,123,952 disclosed cosmetic composition oh oil-in-water type comprising oxyethylenated fatty acid esters of sorbitan as emulsifier.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isis A. Ghali whose telephone number is (571) 272-0595. The examiner can normally be reached on Monday-Thursday, 7:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Isis A Ghali  
Primary Examiner  
Art Unit 1615



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